

Our Docket No.: 42P6482D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Goldschmidt Iki et al.) Examiner: Raman, Usha.
Application No.: 09/779,779) Art Group: 2623
Filed: February 8, 2001)
For: Method and Apparatus for Selecting)
from Multiple Versions of an)
Entertainment Program)

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REPLY BRIEF
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

This Reply Brief is submitted in reply to the Examiner’s Answer dated December 31, 2008. Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences (hereinafter “Board”) for allowance of the above-captioned patent application.

An oral hearing is not desired.

I. EXAMINER'S POSITION IN THE ANSWER

The Examiner's Answer presents a much more clear picture of the state of the art, and the obviousness argument than previous papers filed by the Examiner. Appellants attempt to clearly restate the Examiner position based on the Response to Argument of the Examiner's Answer. If there is any error in this, Appellant invites a sur-reply to correct the record.

In the prior art:

- a) multiple versions of the same entertainment program have been available;
- b) the multiple versions can be displayed on a single screen (Schein Fig. 3);
- c) programmers can present versions of the same entertainment program to different households (Rosser Col. 14: lines 15-17);
- d) a viewer set-top can be set to automatically select programs to record based on stored viewing history (Ismail);
- e) some additional elements are also shown in the references such as, the EPG, user selections, general user preferences, etc.

The Examiner's argument:

The limitations of "different versions" and "user preferences" are fairly broad and the references are to be read as a whole. Accordingly, it would be obvious to apply the programmer's selection in Rosser to the Fig. 3 display of Schein using the EPG and user preferences as in Ismail to "select... one of the multiple versions for display" as claimed.

II. THE NATURE OF THE INVENTION

A. Background

The present invention as recited in Claim 1, presents a new benefit for home television viewers that has never been proposed before. Thirty years ago movies broadcast for late night were edited differently than those broadcast for prime time. Ten

years ago movies might be broadcast in full screen or letterbox formats. They might also be broadcast with or without closed captioning, SAP (Spanish or French dubbing) and Dolby Surround. With the advent of cable, as described in the Delta article, viewers started to see many more choices than were previously offered. Digital television has increased the possible variations.

The difficulty for viewers has been to determine the best version to watch. As shown in Schein Fig. 3, the only information typically available has been channel and time. As shown in Rosser Col. 14, programmers can make the choice for the user, but this might not be the same choice that the viewer would make. In Rosser's example, the anonymous profile is not going to indicate whether the young children are home or off at summer camp. Ismail would suggest that a TV set-top box can be fitted with powerful selecting features, but the features described in the claims are not there.

B. References as a Whole

Before turning to the claims, consider the references “as a whole.” The present invention is directed to “selecting.. one of the multiple versions for display.” Only Rosser addresses this and then only as an additional feature in Col. 14, not related to the crux of the invention. Rosser’s solution is to send viewer demographics and psychographics to programmers so that the programmers can select a version on the viewer’s behalf.

Schein addresses this by showing the different channels and times and allowing the viewer to pick.

Ismail does not address this. It selects other programs, not other versions of “the same selected entertainment program.”

As Appellant understands the Examiner, it would be obvious to look at the Rosser programmer selection and realize that the selection could be done by viewer control, not programmer control. The inventor can then take the Schein Fig. 3 display, add additional information from Rosser and then make the selection by adapting the Ismail technology.

The inspiration would be that Ismail selects programs using user preferences. This would lead to selecting different versions using user preferences. There are two problems with this approach.

1. Against the Trend in the Prior Art

There are many references directed to selecting programs at the set-top-box either automatically or by the user. None of these references, including Schein and Ismail are directed to different versions of the same program. With so many references, if this were so obvious, then it might have been addressed. Even in Rosser, the result is that any one particular household only receives one version. The other versions are sent to other households. There is simply nothing in the prior art, whether taken separately or as a whole that would render the claimed selection process obvious.

The Examiner would appear to work around this obstacle by stating that “different versions” is fairly broad. This is addressed fully in the specific analysis of the claim below. Appellant submits for now that “version” connotes that each different version is different but based on the same thing. The Examiner’s idea that the 11:00 pm showing on HBO1 is a different version from the 11:30 pm showing on HBO2 is not reading the limitation broadly, but reading the reference with hindsight and imagination. There is nothing in Schein to suggest that the version in one showing differs in any way from the version in another showing of the same “Gone with the Wind.”

2. Against Conventional Commercial Practice

Appellant submits that the realization is not so simple. Programmers have been selecting different versions for different broadcast times and different geographical areas, as well as different channels (cable vs. broadcast versions) for years. These decisions are based in part on what a viewer might like to watch, but also on social policy, regulatory restrictions (limits on prime time and broadcast TV) and corporate policy (ABC Family maintains a different reputation from Showtime). Accordingly, the decision of what version to show is not based as much on what a viewer desires as it is on how the particular channel is marketed.

In the present invention, the decision of which version to watch is placed with the viewer. This has never been done before and goes against all conventional thinking on the topic. The Examiner has perhaps confused “possible to do” with “obvious to do.” As in many invention, the difficulty is not in performing the steps of the invention, but in realizing that the steps should be performed at all. (This is obviously true with many new chemical inventions.)

III. THE CLAIMS IN DETAIL

Claim 1 recites in part, “identifying, for each of the multiple versions, if multiple versions are available, a plurality of characteristics of each respective version of the same selected entertainment program.”

The claim makes it clear that each respective version is “of the same selected entertainment program.” As mentioned above, only Rosser admits of programs being available in different versions.

Claim 1 further recites, in part, “selecting... one of the multiple versions for display by comparing the identified characteristics to the received user preferences... and selecting the program that has the most characteristics conforming to the user preferences.”

This claim implies that the characteristics are different from each other. Otherwise there would be no basis for selection. The claim also recites that the characteristics can conform to the user preferences. The application of the characteristics to the user preferences (at the electronic device using preferences stored at the electronic device), is what sets this invention clearly apart from Rosser which has the programmers decide for the user.

The claims delve into further details, such as “determining whether automatic program selection has been configured,” “displaying the identified versions if automatic program selection has not been configured,” and “selecting if automatic program selection has been configured.” None of the references show a system which provides these two options. The Examiner has simply collected features of different systems and put them together with no real motivation.

IV. AUTOMATICALLY SELECTING FROM AMONG DIFFERENT VERSIONS

As explained above, the present application is the first to suggest that a system automatically select from among different version of the same entertainment program by comparing the characteristics of each version to user preferences. This presents a significant departure from conventional thinking and current commercial practices and provides a significant convenience for the viewer.

VIII. CONCLUSION

Appellant respectfully requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

Please charge any shortages and credit any overpayments to our Deposit Account No. 02-2666.

Respectfully submitted,

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Dated: February 5, 2009

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